Rejections under 35 U.S.C 103

Claims 1-5, 16, 23-25 and 39-40 are rejected under 35 U.S.C 103 as being unpatentable over Platzek et al in view of Millius et al or in view of Riess et al (EP 548096). This rejection is respectfully traversed.

EP 548096 (Reiss et al) discloses fluorinated compounds for biomedical use, which are biologically compatible and non-toxic. The compounds are disclosed as particularly strong surfactants. At page 9, lines 7-10, the preparations are disclosed as having utility as contrast agents and for nuclear magnetic resonance imaging.

Milius, previously discussed, relates to certain new perflouroalkyl-containing compounds that are particularly effective as emulsifiers of various fluorocarbon compositions.

Platzek et al. relates to the use of certain paramagnetic perflouroalkyl-containing compounds as contrast agents in magnetic resonance imaging, especially H-based, T_1-weighted imaging.

But nothing suggests to use perflouroalkyl containing emulsifying agents with paramagnetic perflouroalkyl contrast agents.

There is no motivation to combine the cited references to arrive at a galenical formulation comprising paramagnetic perfluoroalkyl and diamagnetic perfluoroalkyl-compounds. Thus, the combination of references, as cited by the Examiner, cannot render the present invention unpatentable because there is no teaching, motivation or suggestion of combining paramagnetic and diamagnetic agents. In arriving at these rejections, the Examiner fails to use the prior art as a whole, and impermissibly uses hindsight and Applicants

invention as the suggestion for combining the references. *In re Gorman*, 18 USPQ2d 1885 (Fed. Cir. 1991). Therefore, in considering the prior art as a whole, one of skill in the art would not be motivated to make the combination, as suggested by the Examiner. The mere fact that it is possible to find isolated disclosures, which might be combined in such a way to produce a new invention, does not necessarily render such new invention obvious unless the prior art also contains something to suggest the desirability of the combination. *In re Gergen*, 11 USPQ2d 1652, (Fed. Cir. 1989).

Moreover, on page 28, first paragraph, the specification states that unexpected advantages are provided by the invention. The prior art references in no way suggest these. Under *In re Soni*, 54 F3d 746 (CCPA 1995), these specification statements are to be taken as proof of patentability.

It is submitted that he claims are in order for allowance. In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues that can be expedited by a telephone conference, the Examiner is courteously invited to telephone Counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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Attorney Docket No.: SCH-1722

Date: April 19, 2004

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I hereby certify that this correspondence is being deposited with the U.S. Postal Services as First Class Mail in an envelope addressed to: Commissioner of Patents, P O Box 1450, Alexandria, VA 22313-1450 on: 4-19-04

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